

## REMARKS

### **Election/Restriction**

Applicant respectfully acknowledges the examiner's withdrawal of claims 37-42 and 53-79 from further consideration.

### **Priority**

The specification has been amended as recommended by the examiner. The cross-noting section at page 1, line 7, is in compliance with 35 U.S.C. §119(e).

### **Oath/Declaration**

A new oath or declaration in compliance with 37 C.F.R. §1.67(a) is attached.

### **Claim Objections**

Claims 50 and 52 have been amended and are in condition for allowance.

### **Claim Rejections - 35 U.S.C. §112**

Claims 1-36 and 43-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) The examiner states that the scope of the "media sufficiently acidic to initiate acid reactive polymerization" is unclear since it is unclear what is polymerized. Claim 1 has been amended to include "a media adapted to initiate acid reactive polymerization of a polymerizable encapsulating material."

(2) The examiner states that the scope of the claims are indefinite since the claims employ open language when defining subgenus or species in an alternative grouping - stating that claim 2 employs "said anionic emulsifiers comprise" where claim 1 employs Markush

language. Also, the examiner states it is unclear what applicant intends when defining the number of carbon atoms in polyoxethylene alcohols, citing claim 2.

Claims 2 and 25-28 have been amended. Persons of ordinary skill in the art would understand from the specification that the number of carbon atoms refers to the alkyl of the alcohol groups. The amendments, therefore, do not narrow the scope of the claims.

(3) The examiner states that claims 7-9 employ improper Markush language in that the claims employ open language “consisting essentially of.” Claims 7-9 have been amended to standard Markush format, and are in condition for allowance.

(4) The examiner states that in claims 10-15, the “ratio”(e.g. wt/vol, weight, volume, or molar) is undefined. Claims 10-15 have been amended to include “wt%.” Persons of ordinary skill in the art would understand from the specification that the claims originally referred to “wt%.” The amendments, therefore, do not narrow the scope of the claims.

(5) The examiner states that in claims 31 and 44 it is unclear what applicant intends by defining “said polyoxyethylene alcohols” twice. Claims 31 and 44 have been amended to correct this clerical error and are in condition for allowance.

Claims 1-36 and 43-52 are in condition for allowance.

### **Claim Rejections - 35 U.S.C. §102**

#### **Otrhalek et al**

Claims 1-29 are rejected under 35 U.S.C. §102(b) as being anticipated by Otrhalek et al. (U.S. Pat. No. 4,032,466).

#### **-Response**

In order to establish a case of *prima facie* anticipation, the examiner must establish that a prior art reference discloses every limitation of the claimed invention either explicitly or

inherently. *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999). Amended claim 1 reads:

A composition **for emulsifying free hydrocarbons in drill cuttings** comprising:  
a combination of non-ionic emulsifiers with anionic emulsifiers **having an HLB effective to emulsify** said free hydrocarbons and comprising a media adapted to initiate acid reactive polymerization of a polymerizable encapsulating material;  
wherein said anionic emulsifiers are selected from the group consisting of alkane sulfates, alkane sulfonates, and phosphate esters; and,  
said non-ionic emulsifiers comprise polyoxyethylene alcohols.

The examiner has not pointed to a teaching or suggestion in Otrhalek et al. of a composition “for emulsifying free hydrocarbons in drill cuttings,” as claimed. Nor has the examiner pointed to a teaching or suggestion in Otrhalek et al. of “a combination of non-ionic emulsifiers with anionic emulsifiers having an HLB effective to emulsify said free hydrocarbons” in drill cuttings. To the extent that the examiner contends that any of the foregoing limitations are inherent in the Otrhalek ‘466 patent, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the [Otrhalek ‘466 patent].” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The new claims 80-173 are drawn to a composition which “consists essentially of” the claimed emulsifiers. The phrase “consisting essentially of” is to be construed as limiting “the scope of a claim to the specified ingredients and those that do not materially affect the basic and novel characteristic(s) of a composition.” *In re Herz*, 190 USPQ 461, 463 (CCPA 1976).

Othalek teaches an “acid cleaner composition,” including “a **flocculating agent**.” *See* Col. 2, ll. 35 and 50. A person of ordinary skill in the art would recognize that a flocculating agent would cause “flocculation,” which is defined as “the combination or aggregation of suspended colloidal particles in such a way that they form small clumps or tufts.” *See* HAWLEY’S CONDENSED CHEMICAL DICTIONARY 528 (10<sup>th</sup> ed. 1987). The examiner has not established that a flocculant would not “materially affect the basic and novel characteristic(s)” of the claimed composition.

**Lambremont et al.**

Claims 1-9, 16-23 and 25-36 are rejected under 35 U.S.C. §102(b) as being anticipated by Lambremont et al. (U.S. Pat. No. 5,707,952).

**-Response**

Claims 16-23 have been cancelled.

Lambremont et al. teaches “a thickened acidic aqueous cleaner for bathtubs and other hard surfaced items.” Col. 2, ll. 19-21. The examiner has not pointed to a teaching or suggestion in Lambremont et al. of a composition “for emulsifying free hydrocarbons in drill cuttings,” as claimed. Nor has the examiner pointed to any teaching or suggestion in Lambremont et al. of “a combination of non-ionic emulsifiers with anionic emulsifiers having an HLB effective to emulsify said free hydrocarbons” in drill cuttings. Thus, the examiner has not established that Lambremont et al. discloses every limitation of the claimed invention either explicitly or inherently. *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ2d at 1945 (Fed. Cir. 1999). Claims 1-9, and 25-36 are in condition for allowance.

The new claims 80-173 are drawn to a composition which “consists essentially of” the claimed emulsifiers. Lambremont et al. teaches a “thickened acidic aqueous cleaner for bathtubs and other hard surfaced items” comprising

a thickener; a deterative proportion of at least one synthetic organic detergent which is capable of removing greasy soil from such surfaces; a lime scale and soap scum removing proportion of an acid, especially a mono or dicarboxylic acid(s) having 2 to 10 carbon atoms or an alpha hydroxy aliphatic acid, and optionally, an aminoalkylenephosphonic acid in such proportion as to prevent damage to zirconium white enamel surfaces of items to be cleaned by the carboxylic acid(s), a preservative, phosphoric acid, and a disinfectant and the balance being water.

Col. 2, ll. 24-34. The examiner has not established that a thickener or other ingredient included in Lambremont et al. would not “materially affect the basic and novel characteristic(s)” of the claimed composition.

**Thomas et al.**

Claims 1-6 and 25-29 are rejected under 35 U.S.C. §102(b) as being anticipated by Thomas et al. (U.S. Pat. No. 5,192,460).

**-Response**

Thomas et al. teaches a microemulsion cleaner “effective in removing lime scale and soap scum from hard surfaces.” Col. 1, ll. 56-58. As stated above, the examiner has not pointed to a teaching or suggestion in Thomas et al. of a composition “for emulsifying free hydrocarbons in drill cuttings,” as claimed. Nor has the examiner pointed to any teaching or suggestion in Thomas et al. of “a combination of non-ionic emulsifiers with anionic emulsifiers having an HLB effective to emulsify said free hydrocarbons” in drill cuttings. Thus, the examiner has not established that Thomas et al. discloses every limitation of the claimed invention either explicitly or inherently. *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ2d at 1945 (Fed. Cir. 1999). Claims 1-6 and 25-29 are in condition for allowance.

The new claims 80-173 are drawn to a composition that “consists essentially of” the claimed emulsifiers. Thomas et al. teaches

a deterative proportion of synthetic organic detergent, which is capable of removing greasy soil from such surfaces; a lime scale and soap scum removing proportion of organic acid(s) having 2 to 10 carbon atoms therein, which group of acids excludes oxalic and malonic acids, an aminoalkylenephosphonic acid, and phosphoric acid, with the proportions of such aminoalkylenephosphonic and phosphoric acids being such as to prevent damage to zirconium white enamel surfaces of items to be cleaned by the organic acid(s) when the cleaner is employed to clean such items; and an aqueous medium for the detergent, organic acid(s), aminoalkylenephosphonic acid and phosphoric acid.

Col. 2, ll. 28-41. The examiner has not established that the ingredients included in Thomas et al. would not “materially affect the basic and novel characteristic(s)” of the claimed composition.

### **Taft**

Claims 1-15 and 25-34 are rejected under 35 U.S.C. §102(b) as being anticipated by Taft (U.S. Pat. No. 3,389,110).

### **-Response**

Taft teaches a “method of producing a copolymeric emulsion containing the following four classes of monomers: (1) aliphatic ester of  $\alpha,\beta$ -unsaturated monocarboxylic acid; (2) polymerizable unsaturated amide; (3) copolymerizable vinyl compound; and (4)  $\alpha,\beta$ -unsaturated mono- or di-carboxylic acid or salt thereof or a monoester of a dicarboxylic acid or salt thereof.” *See* Abstract. Taft also teaches an emulsion having a **pH of 5.2**. Col. 6, line 14. The examiner has not pointed to a teaching or suggestion in Taft of a composition for “for emulsifying free hydrocarbons in drill cuttings,” as claimed. Nor has the examiner pointed to any teaching or suggestion in Taft of “a combination of non-ionic emulsifiers with anionic emulsifiers having an HLB effective to emulsify said free hydrocarbons” in drill cuttings. The examiner certainly has not pointed to a teaching or suggestion in Taft of “an HLB effective to emulsify said free hydrocarbons and comprising **a media adapted to initiate acid reactive polymerization** of a

polymerizable encapsulating material.” Thus, the examiner has not established that Taft discloses every limitation of the claimed invention either explicitly or inherently. *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ2d at 1945 (Fed. Cir. 1999). Claims 1-15 and 25-34 are in condition for allowance.

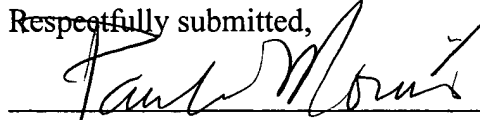
The new claims 80-173 are drawn to a composition which “consists essentially of” the claimed emulsifiers. Taft teaches a “method of producing a copolymeric emulsion containing the following four classes of monomers: (1) aliphatic ester of  $\alpha,\beta$ -unsaturated monocarboxylic acid; (2) polymerizable unsaturated amide; (3) copolymerizable vinyl compound; and (4)  $\alpha,\beta$ -unsaturated mono- or di-carboxylic acid or salt thereof or a monoester of a dicarboxylic acid or salt thereof.” *See* Abstract. The examiner has not established that the monomers included in Taft would not “materially affect the basic and novel characteristic(s)” of the claimed composition.

Even if the examiner does not agree with the foregoing arguments, the examiner has not pointed to a teaching or suggestion of a composition consisting essentially of “drill cuttings” (claims 105-112). Nor has the examiner pointed to compositions “consisting of” only the claimed elements (claims 174-193).

## **CONCLUSION**

For all of the foregoing reasons, Applicant respectfully requests reconsideration and allowance of all of the pending claims.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paula Morris", is written over a horizontal line.

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